

REMARKS

In the Office Action mailed May 7, 2007, the Examiner objected to claim 8 for failing to further limit the subject matter of a previous claim, and rejected claims 1-6 and 9-21 under 35 U.S.C. § 103(a) using various combinations of references. In this Amendment, Applicant amends independent claim 1 to incorporate the subject matter of now canceled claim 13, amends claims 15 and 18 for consistency with claim 1, adds new independent claim 41, which incorporates the subject matter of claim 11, amends claim 16 to depend from new independent claim 41 and to be consistent with new independent claim 41, and cancels claims 8 and 13. Claims 1 and 41 are in independent form. Applicant respectfully requests the Examiner's reconsideration in view of the amendments and arguments set forth herein.

The rejection of claims 1-6, 9, 10, 12-15, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,040,129 ("Steinemann") in view of U.S. Patent No. 5,047,030 ("Draenert") is improper and should be withdrawn. The claims require a "balloon-expandable medical stent." Steinemann and Draenert both fail to disclose balloon-expandable medical stents. Both instead disclose bone screws. Bone screws are not balloon-expandable medical stents.

In addressing the recitation of "balloon-expandable medical stent" in the claims, the Examiner states that this "has been considered as a property limitation, but because Steinemann . . . discloses an alloy with a composition that is substantially similar to the composition of the instant invention, it would be expected that the alloy of Steinemann . . . would also be capable of being 'balloon expandable' as claimed." This is both a misinterpretation of the claim and of the Steinemann bone screw. The Steinemann bone screw would not be balloon-expandable because the Steinemann bone screw does not have a structure that would allow for balloon-expansion. Furthermore, the recitation of "balloon-expandable medical stent" does more than to merely recite a property limitation; it instead requires a certain structure – specifically, a "balloon-expandable medical stent" structure. Accordingly, the Office Action mailed May 7, 2007 fails to present a *prima facie* case of obviousness. Thus the rejection of claims 1-6, 9, 10, 12-15, 19, and 20 over Steinemann in view of Draenert should be withdrawn.

Claims 16-18 were further rejected under 35 U.S.C. § 103(a) as being unpatentable over Steinemann in view of Draenert and "The ASM Handbook Volume 2." The ASM Handbook Volume 2 also fails to disclose a balloon-expandable medical stent and thus the combination of Steinemann, Draenert, and "The ASM Handbook Volume 2" also fails to present a *prima facie* case of obviousness.

The rejection of claims 1-6, 9, 11, 12, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,685,306 ("Davidson") is now moot in view of the amendments. Independent claim 1 has been amended to incorporate the subject matter of now canceled claim 13, which was not rejected over Davidson. As such, the rejection of claims 1-6, 9, 11, 12, 14, and 15 over Davidson should be withdrawn. The rejections of claims 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Davidson in view of "The ASM Handbook Volume 2," and of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Davidson with evidence from U.S. Patent No. 5,653,727 ("Wiktor"), are also moot and should also be withdrawn.

With regard to new independent claim 41, it is noted that Davidson does not disclose "about 40 weight percent or more of Ta." Although Davidson discloses that "[t]antalum can also be present as a substitute for Nb," Davidson only discloses "about 10 wt. % to about 20 wt. % niobium." (Davidson, col. 4, lines 32-38). The Examiner has not provided any reason why one having ordinary skill in the art would modify the alloy of Davidson to include "about 40 weight percent or more of Ta."

Applicant requests that the Examiner allow pending claims 1-6, 9-12, 14-21, and 41. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

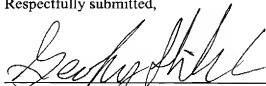
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Respectfully submitted,

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